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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,154

07/16/2003

James L. Sumiejski

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03/23/2009

THE LUBRIZOL CORPORATION

ATTN: DOCKET CLERK, PATENT DEPT.

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WICKLIFFE, OH 44092

EXAMINER

NERANGIS, VICKIE MARIE

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

03/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Attachment to Advisory Action

Applicant's response filed 3/18/2009 has been fully considered but is not persuasive.

Specifically, applicant argues (A) that the mixture of amide and imidazoline species is reasonably commensurate with individual amide and imidazoline species and (B) that the amount of condensation product of 0.03-1 wt % is reasonably commensurate in scope with the scope of the claims.

With respect to argument (A), applicant's argument that the performance of the condensation products comes primarily from the fatty acid and polyamine moieties is found persuasive. However, in light of this statement, the exemplified and preferred friction modifier of Ward which is a condensate of isostearic acid and tetraethylene pentamine (Supplement A, page 27, line 19) should necessarily behave in the same manner as the presently claimed condensation product given that it too has the same fatty acid and polyamine moieties. Because the presently claimed condensation product is an equivalent of a condensate of isostearic acid and tetraethylene pentamine, applicant's data appears to no longer be probative.

With respect to argument (B), the amount of the condensation product of a fatty acid and ethylenepolyamine is not reasonably commensurate in scope with the scope of the claims because each of the examples only contain 0.20 wt % of the friction modifier and the claims are open to any amount of friction modifier. Case law holds that whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range (i.e., scope). *In re Clemens*,

Art Unit: 1796

622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980), MPEP 716.02(d). Applicant has not established if the S1/D values for the presently claimed composition are indeed better than those for compositions containing other friction modifier in amounts other than 0.2 wt % and teaches that the amount of friction modifier is adjusted to provide for the least amount of metal-to-metal coefficient of friction (page 20, lines 24-28). It is the examiner's position that the amount of friction modifier could be changed to control the effect of friction and that it would have been obvious to one of ordinary skill in the art to utilize suitable amounts of friction modifier (whether more or less, both of which fall within the amount of 0.1-0.45 wt %) to control the S1/D values.

3/23/2009

vn

/Vickey Nerangis/

Examiner, Art Unit 1796